

Amendment and Response

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Serial No.: 09/934,031

Confirmation No.: 7794

Filed: 20 August 2001

For: REMOVABLE RETROREFLECTIVE MATERIAL

Remarks

The Office Action mailed 18 October 2005 has been received and reviewed. Claims 15, 19, 38, 40, 41, 42, and 44 having been amended, and claim 43 having been canceled, the pending claims are claims 15-22, 38-42, and 44-59. Claims 15-22 and 38-41 having been withdrawn from consideration by the Examiner as being directed to a non-elected groups, the claims currently under consideration are claims 42 and 44-59.

Claim 42 has been amended to incorporate the language of dependent claim 43 (now canceled), and claim 44 has been rewritten in independent form.

Withdrawn claim 15 has been amended to recite a method of making, for example, an article according to claim 44; and withdrawn claim 19 has been amended to recite a method of making, for example, an article according to claim 42. Withdrawn claims 38, 40, and 41 have been amended to recite methods of using, for example, articles according to claims 42, 44, and 48, respectively.

Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 U.S.C. §102(e)

The Examiner rejected claim 42 under 35 U.S.C. §102(e) as being anticipated by Fleming (U.S. Patent No. 6,306,459). Claim 42 has been amended to incorporate the language of dependent claim 43 (now canceled), i.e., "the single layer backing is medical tape having a foam backing." As noted by the Examiner, "Fleming fails to disclose a medical tape having foam backing" (page 5, 3 lines above bottom of page of the Office Action mailed October 18, 2005). For at least this reason, Applicant respectfully submits that claim 42 (as amended) is not anticipated by Fleming.

Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(e).

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Rejection under 35 U.S.C. §103(a)

The Examiner rejected claims 44-47 and 59 under 35 U.S.C. §103(a) as being unpatentable over Fleming (U.S. Patent No. 6,306,459) in view of Seber (U.S. Patent No. 4,745,916). Applicant respectfully traverses the rejection.

Fleming discloses a "a retroreflective article that includes a colored layer that contains reflective flakes and a dye" (column 1, lines 8-10). As noted by the Examiner (at page 3, last 3 lines of the Office Action mailed October 18, 2005), "Fleming fails to disclose a medical tape having a non-woven backing" (c.g., claim 44). As further noted by the Examiner (at page 5, 3 lines above bottom of page of the Office Action mailed October 18, 2005), "Fleming fails to disclose a medical tape having foam backing" (c.g., claims 45-47). Further, Applicant respectfully submits that Fleming fails to disclose, among other things, that "the layer of retroreflective beads exhibits an initial reflective brightness prior to being subjected to abrasion cycles and a final reflective brightness after being subjected to a number of abrasion cycles, wherein the final reflective brightness is greater than seventy percent of the initial reflective brightness when the number of abrasion cycles is approximately 750," as recited in claim 59.

Seber, which discloses "sun block and glare reflective materials" (column 1, lines 6-7), fails to disclose or suggest a retroreflective article.

Thus, Applicant respectfully submits that the Examiner has failed to provide sufficient motivation for one of skill in the art to combine Fleming, which discloses a retroreflective article, with Seber, which discloses sun block and glare reflective materials, to support a *prima facie* case of obviousness.

The Examiner also rejected claims 43 and 48-58 under 35 U.S.C. §103(a) as being unpatentable over Fleming (U.S. Patent No. 6,306,459) in view of May (U.S. Patent No. 4,648,689). Claim 43 has been canceled. However, to the extent that the rejection applies to claims 42 and 48-58 (as amended), Applicant respectfully traverses these rejection.

Fleming discloses a "a retroreflective article that includes a colored layer that contains

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reflective flakes and a dye" (column 1, lines 8-10). The article "can demonstrate extraordinary durability under industrial wash conditions" (column 4, lines 1-2). As noted by the Examiner (at page 5, 3 lines above bottom of page of the Office Action mailed October 18, 2005), "Fleming fails to disclose a medical tape having foam backing" (e.g., claim 42, 48-54, 56, and 58). Further, Applicant respectfully submits that Fleming fails to disclose, among other things, that "the layer of retroreflective beads exhibits an initial reflective brightness prior to being subjected to abrasion cycles and a final reflective brightness after being subjected to a number of abrasion cycles, wherein the final reflective brightness is greater than seventy percent of the initial reflective brightness when the number of abrasion cycles is approximately 750," as recited in claims 55 and 57.

May discloses "pavement markers used in delineating traffic lanes on highways" (column 1, lines 7-8).

Applicant respectfully submits that the Examiner has failed to provide sufficient motivation for one of skill in the art to combine Fleming, which discloses a retroreflective article that can demonstrate extraordinary durability under industrial wash conditions, with May, which discloses pavement markers used in delineating traffic lanes on highways, to support a *prima facie* case of obviousness.

Moreover, Applicant respectfully submits that Fleming (U.S. Patent No. 6,306,459) is not available as prior art for purposes of obviousness in view of 35 U.S.C. §103(c) as effective November 29, 1999. **At the time the invention of the instant application was made, the claimed invention and Fleming (U.S. Patent No. 6,306,459), were owned by or subject to an obligation of assignment to the same entity.** As such, Applicant respectfully submits that the rejections of claims 43-59 under 35 U.S.C. §103 as being obvious over Fleming in view of Seber or May have been rendered moot.

In view of the remarks presented herein above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

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Request for Rejoinder

Withdrawn claims 15-18 (as amended) are drawn to a method of making, for example, an article according to claim 44. Withdrawn claims 19-22 (as amended) are drawn to a method of making, for example, an article according to claim 42. Withdrawn claims 38-39, 40, and 41 (as amended) are drawn to methods of using, for example, articles according to claims 42, 44, and 48, respectively. Upon an indication of any of article claims 42, 44, and/or 48 being allowable, Applicant respectfully requests that the corresponding method claims also be examined and passed on to allowance pursuant to M.P.E.P. §821.04. *See, for example, In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996).

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of January, 2006, at 10:47 a.m. (Central Time).

By: Name: Rachel Gebhardt-Gebhardt